

"This application contains claims directed to more than one species of the generic invention. These species are deemed to *lack unity of invention* because they are not so linked as to form a single general inventive concept under *PCT Rule 13.1*.

The species are as follows:

Group I	Figs. 1 & 7 as set forth by claims 1-18, 25 and 26
Group II	Fig. 3 as set forth by claims 19, 20 and 27
Group III	Fig. 2 as set forth by claims 21, 23 and 24
Group IV	Fig. 3 as set forth by claim 22"

(Paper No.7 at p.2, lines 3-10, emphasis added).

The Examiner goes on to state that the species of Groups I through IV contain claims directed to *independent inventions*, as follows:

"Group I species employs 'a method of evaluating an application for a financial product'...

Group II species employs 'an apparatus for evaluating an application for a financial product'...

Group III species employs 'a system for evaluating an application for a financial product'...

Group IV species employs 'a computer program product in a computer readable medium..."

Applicants provisionally elect to prosecute Group I (including claims 1-18, 25 and 26). This provisional election is made with traverse; that is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 CFR §1.143.

### ***1. PCT Rules Are Not Applicable***

It appears that the Examiner has inadvertently applied Patent Cooperation Treaty ("PCT") rules to the current case. Applicants respectfully note that the current application is not a PCT application and is thus not subject to PCT rules or requirements. Thus, the Examiner's reliance on the requirement of "unity of invention" (PCT Rule 13.1), is an inappropriate basis for requiring restriction in this case. Applicants therefore request withdrawal of the improperly based restriction. The appropriate United States law is set forth below in combination with the arguments herein.

## ***2. The Examiner has Failed to Establish a Prima Facie Case for Restriction***

Even if the Examiner did not intend to apply PCT law to the current application, a restriction requirement under the appropriate U.S. law would still not be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a prima facie case for restriction.

### **a. Proper Basis for Restriction**

Restriction is proper only where an application contains claims directed to "two or more independent and distinct inventions". (35 USC §121; 37 CFR §§1.141, 1.142; MPEP §802.01). The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". (MPEP §802.01). The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". (*Id.*). To establish a prima facie case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". (MPEP §808). To establish a prima facie case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent" (equivalent to step one for "distinct"-based restriction). (*Id.*).

### **b. The Examiner's Case as Set Forth**

The Examiner has failed to set forth either prima facie case required for a proper restriction requirement. The Examiner merely asserted the conclusory statements that (1) the "species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1" (Applicants again respectfully point out that the current application is not a PCT application, and thus the correct law is cited and applied herein), and (2) "the species are deemed independent inventions...has [sic] having different methods/schemes". (Paper No. 7, pg.2, bullet 1; pg.3, bullet 2). Neither of these conclusory

statements satisfies the Examiner's burden of establishing a prima facie case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions.

**c. A Prima Facie Case for "Independent" Restriction is not Established**

Further, the Examiner asserts that the claimed inventions are "independent". (Paper No. 7, pg.3, line 2). Applicants respectfully disagree with this unsupported assertion. "Independent" inventions, as defined in restriction practice, are "not connected in design, operation, or effect". (MPEP §802.01, 808.01), and are "not capable of use together" (MPEP §808.01). An example of "independent" inventions would be claims directed to both "a necktie and a locomotive bearing". (*Id* at Examiner Note 1). Clearly, where all currently claimed embodiments of the present invention are directed to methods, and apparatus "for evaluating an application for a financial product", no such independence exists.

**d. A Prima Facie Case for "Distinct" Restriction is not Established**

Alternatively, if the Examiner intended to impose the restriction based on "distinct" inventions, the prima facie burden has still not been met. No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. (MPEP §808.02). Absent such showings as required by MPEP §808.02, no prima facie case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." (*Id*). Indeed, Applicants further note that the search has already been completed, removing any possibility of a burden based on search scope or magnitude.

**e. The Restriction is Improperly Based on Statutory Claim Class**

The Examiner has apparently divided the claims into groups based on the 35 USC §101 statutory class of each claim (i.e., process, apparatus, etc.). Specifically, Group I are process

claims, and Group II are apparatus claims. To support a restriction requirement based on "distinct" inventions, "[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process." (MPEP §806.05(e)). "The burden is on the examiner to provide reasonable examples that recite material differences." (*Id.*). The Examiner has provided no such examples or reasons as to why the claimed inventions is Groups I and II are believed to be "distinct". Further, "[i]f the apparatus claims include a claim to 'means' for practicing the process, the claim is a linking claim and must be examined with the elected invention." (*Id.*). Claims 23 and 24 of Group III recite such "means" as contemplated by MPEP §806.05(e) and are therefore "linking" claims that should, were the Examiner to persist with the current restriction, be examined with the elected species. Applicants therefore respectfully request that, in addition to the provisional election of Group I, that claims 23 and 24 be grouped with the elected species to be pursued.

### ***3. The Grounds for Restriction are Not Proper***

Further, Applicants respectfully assert that restriction is not proper here because there is no proper reason for maintaining a restriction in the present case. Thus, even if the Examiner had set forth a *prima facie* case for restriction, restriction would still not be proper in this case. In particular, (1) there is no separate classification of the Groups which would necessitate a separate field of search; (2) the Groups can be searched using the same field of search without unduly burdening the Examiner; and (3) the Groups are not related to any class of invention which has achieved a separate status in the art. In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Indeed, as mentioned *supra*, such a non-burdening search has already been conducted.

### ***4. Conclusion***


In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. All claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims. Applicants' silence

with respect to other comments made in the Office Action (e.g., comments directed to various dependent claims) does not imply agreement with those comments.

If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact Kurt M. Maschoff using the information provided below.

Respectfully submitted,

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Date

  
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